

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

**ERICSSON INC., TELEFONAKTIEBOLAGET
LM ERICSSON, AND ERICSSON AB**

Plaintiff,

vs.

**SAMSUNG ELECTRONICS CO., LTD., AND
SAMSUNG ELECTRONICS AMERICA, INC.,**

Defendants.

Civil Action No. 2:21-cv-00001

JURY TRIAL

**JOINT MOTION FOR MANDATORY STAY OF PROCEEDINGS
PURSUANT TO 28 U.S.C. §1659 FOR PATENTS ALSO BEING LITIGATED BEFORE
THE UNITED STATES INTERNATIONAL TRADE COMMISSION**

Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Ericsson AB (collectively, “Plaintiffs” or “Ericsson”) and Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Defendants” or “Samsung”) jointly move that the Court stay proceedings on the patent infringement claims brought by Ericsson and the declaratory judgment and patent infringement counterclaims brought by Samsung. These claims and counterclaims involve the same eight patents now asserted by the parties in proceedings pending before the U.S. International Trade Commission (“ITC”). The parties have conferred and have agreed on this joint motion.

On January 1, 2021, Ericsson brought an action in this Court, asserting four patents—U.S. Patent Nos. 7,151,430, 6,879,849, 7,286,823, and 9,313,178 (the “Asserted Patents”)—against Samsung. Dkt. No. 1 (Counts I-IV). On January 4, 2021, Ericsson filed a complaint at the ITC asserting the same four Asserted Patents against Samsung. *See In the Matter of Certain Electronic Devices with Wireless Connectivity, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-1245 (“Inv. 1245”), Inst. of Inv. (Feb. 2, 2021). (Ex. A hereto). On February 2, 2021,

the ITC instituted investigation on all four Asserted Patents. *Id.* ITC Inv. 1245 involves all parties to Ericsson’s patent infringement claims in this case: Plaintiffs Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Ericsson AB are the complainants in Inv. 1245, and Defendants Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. are two of the five named respondents in Inv. 1245. *Id.* at 2-3.

On January 7, 2021, Samsung filed its Answer and Counterclaims in the action here, asserting declaratory judgment counterclaims of non-infringement and invalidity of the Asserted Patents and patent infringement counterclaims on four patents—U.S. Patent Nos. 9,041,074, 9,521,616, 10,797,405, and 9,736,772 (the “Counterclaim Patents”)—against Ericsson. Dkt. No. 16 (Counts I-VI). That same day, Samsung filed a complaint at the ITC asserting the same four Counterclaim Patents against Ericsson. *See In the Matter of Certain Wireless Communications Equipment and Components Thereof*, Inv. No. 337-TA-1247 (“Inv. 1247”), Inst. of Inv. (Feb. 8, 2021). (Ex. B hereto). On February 8, 2021, the ITC instituted investigation on all four Counterclaim Patents. *Id.* ITC Inv. 1247 involves all parties to Samsung’s patent infringement counterclaims in this case: Counterclaim-Plaintiffs Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. are the complainants in Inv. 1247, and Counterclaim-Defendants Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Ericsson AB are the respondents in Inv. 1247. *Id.* at 2-3. Likewise, Samsung’s declaratory judgment counterclaims of non-infringement and invalidity of the Asserted Patents (Dkt. No. 16, Counts I-II) involve the same issues, patents, and parties as Ericsson’s Inv. 1245 action at the ITC. *See* Ex. A at 2-3.

Pursuant to the mandatory stay provisions of 28 U.S.C. § 1659, the Court must stay each of Ericsson’s four patent infringement claims, Samsung’s four patent infringement counterclaims, and Samsung’s two declaratory judgment counterclaims, which involve the same eight patents

presently asserted in the instituted ITC actions. Section 1659 mandates a stay of district court proceedings with respect to claims involving the same issues and parties that are also involved in ITC proceedings, upon request of an ITC respondent. 28 U.S.C. § 1659(a) (“... the district court shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission....”). A § 1659 stay is mandatory and non-discretionary. *See Fuji Photo Film Co., Ltd. v. Benun*, 463 F.3d 1252, 1256 (Fed. Cir. 2006) (“[T]he district court must await a final decision from the Commission before proceeding with its action.”). The mandatory stay remains in effect “until the determination of the Commission becomes final.” 28 U.S.C. § 1659(a).

For the foregoing reasons, Ericsson and Samsung respectfully request that the Court grant this joint motion and stay all proceedings on Ericsson’s claims (Counts I-IV) and Samsung’s counterclaims (Counts I-VI) until the determination of the ITC becomes final.

At this time, the parties by way of this motion do not seek a stay on the pending claims of any other dispute between the parties before this Court, including Case No. 2:21-cv-010, which was consolidated into this action on February 8, 2021. *See* Dkt. No. 22.

Dated: February 16, 2021.

/s/ Melissa R. Smith

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a), and therefore served on all counsel who have consented to electronic service on February 16, 2021.

/s/ Theodore Stevenson, III

Theodore Stevenson, III

CERTIFICATE OF CONFERENCE

In compliance with Local Rule CV-7(i), I hereby certify that counsel for all parties have met and conferred via correspondence, and this motion is unopposed.

/s/ Theodore Stevenson, III

Theodore Stevenson, III